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EXAMINER	
SHIN, KYUNG H	
ART UNIT	**PAPER NUMBER**
2143	

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/818,003	RATCLIFF, RAYMOND F.	
	Examiner	Art Unit	
	Kyung H. Shin	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 October 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is responding to application amended 10/11/2005 and filed 3/27/01.

2. Claims **1 - 52** are pending. **Claims 1, 12, 16, 22, 30, 34, 38, 42 were previously amended, and Claims 45 - 52 were added as new on** 1/25/2005. Independent claims are **1, 12, 16, 22, 30, 34, 38, 42, 45, 47, 48, 49.**

Response to Arguments

3. Applicant's arguments, see *Remarks Page 13,* filed 10/11/2005, with respect to request for withdrawal of finality of June 2, 2005 Office Action and Claims 38-41 rejections under *35 USC § 101* have been fully considered and are persuasive. The Final Office Action of June 2, 2005 and Claims 38-41 rejections under *35 USC § 101* have been withdrawn. However, upon further consideration, the new ground(s) of rejection presented in this Office action **IS FINAL**.

Response to Remarks

3.1 Applicant argues that the referenced prior art *" ... teaches away from sending document data through a communications path ... " (see Remarks Page 16, Lines 26-27)* ; Applicant argues that the referenced prior art discloses *" ... to replace the tokens with actual document data ... " (see Remarks Page 18, Lines 25-26 ; Page 24, Lines 2-3)*

The Applicant argues that the Eldridge (6,515,988) prior art teaches away from sending the entire set of data for a document through a communications path. However, the Eldridge (6,515,988) prior art does disclose sending a set of information (i.e. designated as a token), which is utilized to identify a document. The Applicant's "document data" is a subset of the entire set of data in a document. Based on claim 1, this particular "document data" is utilized to identify a document, therefore, "document data" is utilized as a document identifier and is not the entire set of data within a document.

The Eldridge (6,515,988) prior art discloses the capability to enable the usage of a document identifier (i.e. the aforementioned token), which is utilized to identify a particular document for processing. The concept of "document data" is analogous art for the Eldridge (6,515,988) prior art designated as a token or a document identifier. (see Eldridge col. 2, lines 6-10: token utilized as a document identifier, transmitted between system for identification) In addition, the Applicant argues that a URL is utilized as the only identification for a document. A URL may be utilized to identify a document but is merely a part of the identification within a token.

The Eldridge (6,515,988) and Neukermans (6,229,139) prior art combination does not disclose the replacement of the token concept. The combined teachings disclose the additional feature of adding "document data" to the token concept. In this configuration, "document data" is utilized as an additional parameter within the document identifier (i.e. a token). In addition,

the Eldridge (6,515,988) prior art discloses that the configuration of the token is based on user access requirements. (see Eldridge col. 2, lines 10-11: information required for access)

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

3.2 Applicant argues that the referenced prior art does not disclose *" ... extracting at least a portion of the information received from the handheld device as scanning data, wherein the information comprises actual data from a document ... " (see Remarks Page 24, Lines 2-3)* ; Applicant argues that the referenced prior art does not disclose *" ... storing the captured information in the memory of the handheld device as document data ... " (see Remarks Page 15, Line 10)*

The Eldridge (6,515,988) and Neukermans (6,229,139) prior art combination discloses the capture (i.e. extraction utilizing a scanner) of a subset of actual data from a document, which is designated as "document data" or scanning data and utilized within a token for transmission from a handheld device for document identification. (see Eldridge col. 2, lines 6-10: token utilized as a document identifier, transmitted between system for

identification ; see Neukermans col. 3, lines 51-56; col. 3, lines 62-66: capture "document data")

The Eldridge (6,515,988) and Neukermans (6,229,139) prior art combination discloses the capability to store this "document data" within memory for processing into the document identifier (i.e. a token). (see Eldridge col. 2, lines 6-10: token utilized as a document identifier, transmitted between system for identification ; see Neukermans col. 3, lines 51-56; col. 3, lines 62-66: capture data from document utilizing scanning capabilities, subset of data from document)

3.3 Applicant argues that the referenced prior art does not disclose *" ... sending the retrieved document data from the handheld device to the data processing apparatus through the communications path for identification of the document ... " (see Remarks Page 15, Lines 24-25)*

The Eldridge (6,515,988) and Neukermans (6,229,139) prior art combination discloses sending the document identifier (i.e. a token utilizing the "document data") through a communications path and utilized for identification of a document. (see Eldridge col. 2, lines 6-10: token utilized as a document identifier, transmitted between system for identification)

3.4 Applicant argues that the referenced prior art does not disclose *" ... providing a plurality of reference documents, each reference document having associated reference data stored in a memory ... " (see Remarks Page 18, Lines 30-31)*

The Eldridge (6,515,988) prior art discloses a plurality of documents and

that each of the documents has reference information stored in a memory. The associated referenced information is the designated token. (see Eldridge col. 10, lines 25-27; col. 2, lines 10-11: plurality of documents, token utilized as document identification)

3.5 In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the Eldridge (6,515,988) and Neukermans (6,229,139) prior art combination discloses the capability to capture a subset of the data within a document and utilize this captured data (i.e. "document data") within a document identifier (i.e. a token) for document identification.

3.6 In reply to an obviousness rejection under 35 U.S.C. § 103, applicant argues that the secondary reference and primary reference combination is not allowed due to nonobviousness.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of

the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, in response to applicant's arguments against the reference individually, one cannot show nonobviousness by attacking references individually where rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims **42-44** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical

application of the algorithm was in connection with the programming of a general purpose computer."). ..... When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory and should be rejected under 35 U.S.C. § 101. (See **Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility on** page 51)

Claims 42-44 which indicate carrier wave are not limited to tangible embodiments. In view of Applicant's disclosure, specification page 18, line 7, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., RAMs, EPROMs, EEPROMs,) and intangible embodiments (e.g., a carrier wave such as an electronic signal transferred). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claim Rejections - 35 USC § 103

6. **Claims 1, 2, 7 - 9, 12 - 19, 21 - 23, 30, 31, 33 - 42, 44, 45 - 52** are rejected under 35 U.S.C.103(a) as being unpatentable over **Eldridge et al.** (US Patent No. 6,515,988) and in view of **Nuekermans et al.** (US Patent No. 6,229,139).

Regarding Claim 1, Eldridge discloses a method for sending information to a data processing apparatus for identification of a document having the information using a

handheld device capable of communicating with the data processing apparatus, the handheld device having a memory, the method comprising:

a) providing the document; (see Eldridge col. 1, lines 28-35)

c) storing the captured information in the memory of the handheld device as document data; (see Eldridge col. 1, lines 50-53)

d) establishing a communications path between the handheld device and the data processing apparatus; (see Eldridge col. 4, line 64 - col. 5, line 3)

e) retrieving the document data from the memory of the handheld device; (see Eldridge col. 5, lines 23-28) and

f) sending the retrieved document data from the handheld device to the data processing apparatus through the communications path for identification of the document. (see Eldridge col. 1, lines 64-67; col. 3, lines 11-12)

b) Eldridge discloses usage of tokens (i.e. identification information or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans discloses handheld device with attached scanner wherein usage for capturing the information from the document, wherein the information comprises actual data from the document; (see Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6: *" ... A document scanner in accordance with the present invention provides the mobile user with very light weight, high speed, high resolution, low power document scanning capability in any environment ..."*)

Regarding Claims 2, 23, Eldridge discloses the method of claims 1, 22 wherein the document is an electronic document. (see Eldridge col. 1, lines 32-35; col. 9, lines 24-29)

Regarding Claims 7, 35, 46, Eldridge discloses the method of claims 1, 34, 35 wherein the handheld device is a cellular phone. (see Eldridge col. 5, lines 35-40)

Regarding Claims 8, 36, Eldridge discloses the method of claims 1, 34 wherein the handheld device is a personal digital assistant ("PDA"). (see Eldridge col. 5, lines 23-28)

Regarding Claims 9, 37, Eldridge discloses the method of claims 1, 34 wherein the handheld device is a watch. (see Eldridge col. 1, lines 23-28)

Regarding Claim 12, Eldridge discloses in a data processing apparatus, a method for identifying a document for sharing with a recipient, the method comprising:

a) providing a plurality of reference documents, each reference document having reference data stored in a memory; (see Eldridge col. 1, lines 28-35)

c) extracting at least a portion of the received document data as scanning data; (see Eldridge col. 5, lines 19-23)

d) retrieving the reference data from the memory; (see Eldridge col. 1, lines 64-67; col. 3, lines 11-12)

e) comparing the scanning data with the reference data; and selecting, when the scanning data matches at least a portion of the reference data of one of the reference documents, the one reference document as the identified document. (see Eldridge col. 2, lines 26-28)

b) Eldridge discloses usage of tokens (i.e. identification information or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans discloses handheld device with attached scanner wherein usage for receiving, from a handheld device, document data associated with one of the reference documents, wherein the document data comprises actual data from the document; (see Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

Regarding Claims 13, 39, 50, 51, Eldridge discloses the method of claims 12, 16, 38 wherein the scanning data extracted from the received document data includes digital text data identifying a name of the one reference document. (see Eldridge col. 2, lines 36-39)

Regarding Claims 14, 40, Eldridge discloses the method of claims 12, 38 wherein the scanning data extracted from the received document data includes digital text data identifying an author of the one reference document. (see Eldridge col. 2, lines 36-39)

Regarding Claims 15, 41, Eldridge discloses the method of claims 12, 38 wherein the scanning data extracted from the received document data includes digital text data identifying a publication date of the one reference document. (see Eldridge col. 2, lines 36-39)

Regarding Claims 16, 48, Eldridge discloses in a data processing apparatus, a method

for identifying a document and sharing the identified document with a recipient, the data processing apparatus coupled to a data network, the method comprising:

a) providing a plurality of reference documents, each reference document having associated reference data stored in a memory; (see Eldridge col. 1, lines 28-35)

c) extracting at least a portion of the captured information as scanning data; (see Eldridge col. 5, lines 19-23)

d) retrieving the reference data from the memory; (see Eldridge col. 1, lines 64-67; col. 3, lines 11-12)

e) comparing the scanning data with the reference data; selecting, when the scanning data matches at least a portion of the reference data associated with one of the reference documents, the one reference document as the identified document; (see Eldridge col. 2, lines 26-28) and

f) sending, using the address information, the selected document to the receiving address of the recipient. (see Eldridge col. 5, lines 14-17)

b) Eldridge discloses usage of tokens (i.e. identifier or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans discloses receiving, from a handheld device in communication with the data processing apparatus, information captured from a source document by the handheld device, wherein the document data comprises actual data from the document and address information identifying a receiving address for the recipient; (see

Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

Regarding Claim 17, Eldridge discloses the method of claim 16 wherein the scanning data extracted from the received document data includes digital text data identifying a name of the source document. (see Eldridge col. 2, lines 36-39)

Regarding Claim 18, Eldridge discloses the method of claim 16 wherein the scanning data extracted from the received document data includes digital text data identifying an author of the source document. (see Eldridge col. 2, lines 36-39)

Regarding Claim 19, Eldridge discloses the method of claim 16 wherein the scanning data extracted from the received document data includes digital text data identifying a publication date of the source document. (see Eldridge col. 2, lines 36-39)

Regarding Claim 21, Eldridge discloses the method of claim 16 wherein sending the selected document includes: sending the selected document to the receiving address

via facsimile transmission. (see Eldridge col. 2, lines 8-10)

Regarding Claim 22, Eldridge discloses a method for sharing with a recipient a document having information using a handheld device having a memory and capable of communicating with a data processing apparatus in communication with a data network, the method comprising:

b) storing the captured information in the memory of the handheld device; (see Eldridge col. 1, lines 50-53)

c) providing, to the handheld device, address information identifying a receiving address for the recipient; (see Eldridge col. 6, lines 48-53)

d) storing, in the memory of the handheld device, the address information; (see Eldridge col. 6, lines 48-53)

e) establishing a communications path between the handheld device and the data processing apparatus; (see Eldridge col. 4, line 64 col. 5, line 3)

f) sending the captured information and the address information from the handheld device to the data processing apparatus via the communications path; (see Eldridge col. 1, lines 64-67; col. 3, lines 11-12)

g) receiving, by the data processing apparatus, the captured information and the address information from the handheld device; (see Eldridge col. 5,lines 23-28)

h) extracting at least a portion of the captured information as scanning data; (see Eldridge col. 5, lines 19-23)

i) providing a plurality of reference documents, each reference document having reference data stored in a reference memory; (see Eldridge col. 1, lines 28-35)

j) retrieving the reference data from the reference memory; (see Eldridge col. 1, lines 64-67; col. 3, lines 11-12)

k) comparing the scanning data with the reference data; selecting, when the scanning data matches at least a portion of the reference data of one of the reference documents, the one reference document as the identified document; (see Eldridge col. 2, lines 26-28) and

l) sending, using the address information, the selected document to the receiving address of the recipient. (see Eldridge col. 5, lines 14-17)

a) Eldridge discloses usage of tokens (i.e. identifier or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans discloses handheld device with attached scanner wherein usage for capturing the information from the document using the handheld device, wherein the document data comprises actual data from the document; (see Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans.

One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

Regarding Claim 30, Eldridge discloses a data processing apparatus for identifying one of a plurality of reference documents for sharing with a recipient in communication with a data network, each reference document having reference data, from information received from a handheld device in communication with the data processing apparatus, the data processing apparatus coupled to the data network, the apparatus comprising:

a) a memory in which a plurality of instructions are stored; (see Eldridge col. 5, lines 5-10) and

b) a processor coupled to the memory (see Eldridge col. 5, lines 5-10) and coupled to:

(i) access the reference data in a storage medium, and

(ii) Eldridge discloses usage of tokens (i.e. identifier or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans discloses handheld device with attached scanner wherein usage for receive the information from the handheld device, wherein the document data comprises actual data from the document, (see Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage) the

processor capable of executing the instructions in the memory, execution of the instructions causing a plurality of steps to be performed including:

a) extracting at least a portion of the information received from the handheld device as scanning data, (see Eldridge col. 5, lines 19-23)

b) comparing the scanning data with the reference data, and selecting, when the scanning data matches at least a portion of the reference data of one of the reference documents, the one reference document as the identified document. (see Eldridge col. 2, lines 26-28)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

Regarding Claim 31, Eldridge discloses the data processing apparatus of claim 30, execution of the instructions by the processor causing further steps to be performed, namely:

a) establishing a communications path between the data processing apparatus and the recipient via the data network, (see Eldridge col. 4, line 64 - col. 5, line 3) and

b) sending, using the address information, the selected document to the receiving address of the recipient via the communications path. (see Eldridge col. 5, lines 14-17)

Regarding Claim 33, Eldridge discloses the method of claim 31 wherein sending the selected document includes: sending the selected document to the receiving address via facsimile transmission. (see Eldridge col. 2, lines 8-10)

Regarding Claim 34, Eldridge discloses a system for identifying one of a plurality of reference documents, each reference document having associated reference data, for sharing the identified document with a recipient, the system comprising:

a) a data processing apparatus in communication with a data network; (see Eldridge col. 1, lines 28-35) and

b) a handheld device having a memory and capable of:

i) Eldridge discloses usage of tokens (i.e. identifier or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans discloses handheld device with attached scanner wherein usage for capturing the information from the document, wherein the document data comprises actual data from the document, (see Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

ii) storing the captured information in the memory, (see Eldridge col. 1, lines 50-53)

iii) storing, in the memory, address information identifying a receiving address for the recipient, (see Eldridge col. 1, lines 50-64; col. 2, lines 26-28)

iv) establishing a communications path with the data processing apparatus, (see Eldridge col. 4, line 64 - col. 5, line 3) and

v) sending the captured information and the address information from the handheld device to the data processing apparatus via the communications path; (see Eldridge col. 1, lines 64-67; col. 3, lines 11-12)

the data processing apparatus capable of:

a) receiving the captured information and the address information from the handheld device, (see Eldridge col. 1, lines 50-64; col. 3, lines 11-12)

b) extracting at least a portion of the captured information as scanning data, (see Eldridge col. 5, lines 19-23)

c) accessing the reference data, (see Eldridge col. 1, lines 64-67; col. 3, lines 11-12)

d) comparing the scanning data with the reference data, selecting, when the scanning data matches at least a portion of the reference data associated with one of the reference documents, the one reference document as the identified document, (see Eldridge col. 2, lines 26-28)

e) establishing a communications path between the data processing apparatus and the recipient via the data network, (see Eldridge col. 4, lines 64 - col. 5, line 3) and

f) sending, using the address information, the selected document to the receiving address of the recipient via the communications path. (see Eldridge col. 5, lines 14-17)

Regarding Claims 38, 42, Eldridge discloses a processor readable storage medium having processor readable program code such that, when executed by a processor in a data processing apparatus, performs a method for identifying one of a plurality of reference documents for sharing with a recipient, each reference document having reference data, from information received by the data processing apparatus from a handheld device in communication with the data processing apparatus, the method comprising:

b) extracting at least a portion of the information received from the handheld device as address information identifying a receiving address for the recipient; (see Eldridge col. 1, lines 50-64; col. 2, lines 26-28)

c) comparing the scanning data with the reference data; selecting, when the scanning data matches at least a portion of the reference data of one of the

reference documents, the one reference document as the identified document; (see Eldridge col. 2, lines 26-28) and

e) sending, using the address information, the selected document to the receiving address of the recipient. (see Eldridge col. 5, lines 14-17)

a) Eldridge discloses usage of tokens (i.e. identifier or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans discloses handheld device with attached scanner wherein usage for extracting at least a portion of the information received from the handheld device as scanning data, wherein the document data comprises actual data from the document; (see Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

Regarding Claim 44, Eldridge discloses the method of claim 42 wherein sending the selected document includes: sending the selected document to the receiving address

via facsimile transmission. (see Eldridge col. 2, lines 8-10)

Regarding Claim 45, Eldridge discloses a method for sending information to a data processing apparatus for identification of an item using a handheld device capable of communication with the data processing apparatus, the handheld device having a memory, the method comprising:

b) storing the captured information in the memory of the handheld device as data; (see Eldridge col. 1, lines 50-53)

c) establishing a communications path between the handheld device and the data processing apparatus; (see Eldridge col. 4, line 64 - col. 5, line 3)

d) retrieving the captured information from the memory of the handheld device; (see Eldridge col. 5, lines 23-28) and

e) sending the retrieved data from the handheld device to the data processing apparatus through the communications path for identification of the item. (see Eldridge col. 1, lines 64-67; col. 3, lines 11-12)

a) Eldridge discloses usage of tokens (i.e. identifier or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans discloses handheld device with attached scanner wherein usage for capturing information from the item, wherein the information comprises actual data from the item; (see

Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

Regarding Claim 47, Eldridge discloses a method, comprising:

a) providing a plurality of reference items, each reference item having associated reference data stored in a memory; (see Eldridge col. 1, lines 28-35)

c) extracting at least a portion of the captured information as scanning data; (see Eldridge col. 5, lines 19-23)

d) comparing the scanning data with the reference data; selecting, when the scanning data matches at least a portion of the reference data associated with one of the reference items, the one reference item as the identified item; (see Eldridge col. 2, lines 26-28) and

f) sending, using the address information, the identified item to the receiving address of the recipient. (see Eldridge col. 5, lines 14-17)

b) Eldridge discloses usage of tokens (i.e. identification information or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token

contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans discloses handheld device with attached scanner wherein usage for receiving, from a handheld device in communication with the data processing apparatus, information captured from an item by the handheld device, wherein the information comprises actual data from the item, and address information identifying a receiving address for the recipient; (see Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

Regarding Claims 48, 49, Eldridge discloses a method, comprising:

a) providing a plurality of reference documents, each reference document having associated reference data stored in a memory; (see Eldridge col. 1, lines 28-35)

c) extracting at least a portion of the captured information as scanning data; (see Eldridge col. 5, lines 19-23)

d) comparing the scanning data with reference data; selecting, when the scanning data matches at least a portion of the reference data associated with one of the reference documents, the one reference document as the identified document. (see Eldridge col. 2, lines 26-28)

b) Eldridge discloses usage of tokens (i.e. identification information or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans discloses handheld device with attached scanner wherein usage for receiving, from a handheld device in communication with the data processing apparatus, information captured from a document by the handheld device, wherein the information comprises actual data from the document; (see Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

Regarding Claim 51, 52, Eldridge discloses the method of claims 16, 38 wherein the scanning data extracted from the received document data includes digital text data identifying a name of a publication in which the source document appears. (see Eldridge col. 8, lines 22-26)

7. **Claims 3 - 6, 24 - 27** are rejected under 35 U.S.C.103 (a) as being unpatentable over by **Eldridge-Nuekermans** and further in view of **Hayakawa** (US Patent No. 6,765,559)

Eldridge discloses an electronic document server with a network accessible repository (see Eldridge col. 9, lines 24-29: *"... request for a document held in an electronic repository ... stored on a remote file server 52 (which may be in a different building or in a different country)"*). Eldridge does not disclose the capability to access and process specific physical documents such as a newspaper, magazine, or other periodicals publications. However, Hayakawa discloses the capability to access and process specific physical documents such as a newspapers, magazines, or other periodical publications.

Regarding Claims 3, 24, Hayakawa discloses the method of claims 1, 22 wherein the document is a physical document. (see Hayakawa col. 1, lines 43-47) It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to include the capability to access and process specific physical documents such as a newspaper, magazine, or other periodical publication. One

would have been motivated to substitute the capabilities in Hayakawa in order to extend and enhance the processing capabilities of the document processing system.

Regarding Claims 4, 25, Hayakawa discloses the method of claims 3, 24 wherein the physical document is a periodical article. (see Hayakawa col. 1, lines 14-19) Referring to claims 4, 25, claims 4, 25 encompass the same scope of the invention as that of the claims 3, 24. Therefore, claims 4, 25 are rejected for the same reason and motivation as the claims 3, 24.

Regarding Claims 5, 26, Hayakawa discloses the method of claims 3, 24 wherein the physical document is a newspaper article. (see Hayakawa col. 1, lines 14-19) Referring to claims 5, 26, claims 5, 26 encompass the same scope of the invention as that of the claims 3, 24. Therefore, claims 5, 26 are rejected for the same reason and motivation as the claims 3, 24.

Regarding Claims 6, 27, Hayakawa discloses the method of claims 3, 24 wherein the physical document is a magazine article. (see Hayakawa col. 1, lines 14-19) Referring to claims 6, 27, claims 6, 27 encompass the same scope of the invention as that of the claims 3, 24. Therefore, claims 6, 27 are rejected for the same reason and motivation as the claims 3, 24.

8. **Claims 10, 20, 28, 32, 43** are rejected under 35 U.S.C.103 (a) as being

unpatentable over by **Eldridge-Nuekermans** and further in view of **Browning** (US Patent No. 6,707,781)

Eldridge discloses a server system with a network accessible repository for electronic documents. (see Eldridge col. 1, lines 23-28: *"This system can include any number workstations, file servers, ... coupled in a network, and a number of portable devices (e.g. handheld or wristwatch computer) carried by users ...."*) Eldridge does not specifically disclose the capability to scan a physical document (generate an image), decode this into a digital data representation and place it into data storage. Eldridge does not disclose the capability to process a digital document by the attachment of this electronic document to an e-mail message. However, Browning does disclose the capability to scan a physical document (i.e. generate an image), decode it into digital data and place the final digital representation into system storage. Further, Browning discloses the capability to process a electronic digital document and attach it to an e-mail message.

Regarding Claims 10, 28, Browning discloses the method of claim 1 wherein: capturing the information includes:

a) scanning the document to generate scanned information, and converting the scanned information to digital text data; (see Browning col. 1, lines 50-53) and
b) wherein storing the captured information includes storing the digital text data. (see Browning col. 2, lines 16-19)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge with the capability to scan a physical document (i.e. generate an image), decode it into digital data and place it into storage. One would have been motivated to substitute the capabilities in Browning in order to enhance and integrate the capabilities of processing physical documents in the document server system.

Regarding Claims 20, 32, 43, Browning discloses the method of claims 16, 31 wherein sending the selected document includes: attaching the selected document to an e-mail message, and sending the e-mail message to the receiving address via the data network. (see Browning col. 2, lines 9-15)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge with the capability to process an electronic document by its attachment to an e-mail message before network transmission. One would have been motivated to substitute the capabilities in Browning in order to include and enhance the techniques of electronic messaging within the document management system.

9. **Claims 11, 29** are rejected under 35 U.S.C.103(a) as being unpatentable over by **Eldridge-Nuekermans** and further in view of **Hochendoner** (US Patent No. 6,771,568).

Eldridge discloses a document server with a network accessible repository for

electronic documents. (see Eldridge col. 9, lines 24-29: "*... request for a document held in an electronic repository ...stored on a remote file server 52 (which may be in a different building or in a different country),*"). Eldridge does not specifically disclose the capability to input an audio analog signal message, decode this message into digital data and its placement into data storage. However, Hochendoner does specifically disclose the capability to input an audio analog signal message, decode this message into audio digital data and its placement into data storage.

Regarding Claims 11, 29, Hochendoner discloses the method of claim 1 wherein: capturing the information includes:

a) providing the information as spoken audio, (see Hochendoner col. 3, lines 34-36) and converting the spoken audio to a digital audio signal; and

b) wherein storing the captured information includes storing the digital audio signal. (see Hochendoner col. 3, lines 23-26)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge with the capability to input an audio analog signal message, decode this message into digital data and its placement into data storage. One would have been motivated to substitute the capabilities in Hochendoner for the integration of multimedia content into the data processing apparatus in order to fulfill a need to receive audio signal from any type of handheld devices.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyung H. Shin whose telephone number is (571) 272-3920. The examiner can normally be reached on 9 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Dec. 8, 2005

JEFFREY PWU
PRIMARY EXAMINER